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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/803,806

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James Marggraff

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MURABITO, HAO & BARNES, LLP
TWO NORTH MARKET STREET, THIRD FLOOR
SAN JOSE, CA 95113

EXAMINER

WEBER, CHRISTOPHER STEVEN

ART UNIT

PAPER NUMBER

3714

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

04/27/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/803,806

Applicant(s)

MARGGRAFF ET AL.

Examiner

Christopher S. Weber

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 37-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/02/06, 8/01/06, 8/16/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This office action is in response to Applicant's amendment filed on August 28, 2006. Applicant amends claims 37, 38, 40, 45, 46, 47, 49, 50, 52, 57, 58, 59, 61, 62, 64, 69, 70 and 71; responds to claim objections; and responds to claim rejections. Claims 37-72 remain pending.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 42, 54 and 66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim s 42, 54 and 66 recites the limitation "wherein the task is". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 37-39, 41-51, 53-63, 65-72 are rejected under 35 U.S.C. 102(b) as being anticipated by Morgan US Patent 5,596,698.

6. Regarding at least claims 37, 45, 49, 57, 61 and 69, Morgan discloses a processor (Fig.3, (16)); an input device for accepting unstructured user input, writing, by reading a plurality of substantially invisible codes, this is done when the Morgan device tracks and replaces the invisible code (i.e. the interface between the stylus, digitizer and processor) and replaces it with simulated ink, (i.e., stylus and digitizer, Fig.3 item 14 & Col 7 Lines 45 – 60 & Col 10 Lines 16-30); and an output device (e.g., speaker, Fig.3, (34)); wherein the processor recognizes print elements, writing, and its relationship with invisible code, see above; determining instructional response and then outputting that response, Fig 2L.

7. Regarding Claims 38, 50, and 62, Morgan discloses wherein the unstructured user input comprises a print element (e.g., a word) created by the user on a surface. See Co1.4: 47-51.

8. Regarding Claims 39, 51, and 63, Morgan discloses the computing device further comprising a writing element (i.e., a stylus simulating a pen). See Col.3: 32-34.

9. Regarding Claims 41,53, and 65, Morgan discloses wherein the output device is an audio output device (i.e., speaker). See Fig.3.

10. Regarding Claims 42-43, 54-55, and 66-67, Morgan discloses wherein the task is audibly presented to the user by the audio output device and wherein the instructional response is an audio instructional response presented to the user by the audio output device in Col.4: 46-47: For reading and spelling courses, the TeachPad computer 10 would use video and audio to present the word.

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11. Regarding Claims 44, 56, and 68, Morgan discloses wherein the output device is configured to generate an audio output (i.e., feedback) related to a user created print element on a writing surface. See Co1.4: 42-43.

12. Regarding Claims 46-47, 58-59, and 70-71, Morgan discloses wherein the unstructured input is a non-keyboard (i.e., writing) user input and wherein the instructional response relates to the task presented to the user. See Col.4: 42-43.

13. Regarding Claims 48, 60, and 72, Morgan discloses a writing device and wherein the processor, input device, output device and writing device (i.e., stylus and digitizer) are associated with a housing having a pen-like appearance. See Fig.3.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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16. Claims 40, 52 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morgan as applied to claims 37, 49, and 61 above in view of Greanias et al. US Patent 5,007,085.

17. Morgan discloses audio output corresponding to print elements, Col 9 Line 60 – Col 10 Line 3, however Morgan does not explicitly disclose the stylus having an optical detector coupled to the processor. Greenias discloses that this teaching is well known to the art, Col 1 Lines 29-44. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the optical stylus taught by Greenias with the device taught by Morgan in order to provide an interactive input device for use at the display surface.

18. **Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Response to Arguments

19. Applicant's arguments filed August 28, 2006 have been fully considered but they are not persuasive. All arguments regarding any lack of disclosure of Morgan due to applicant's amendment have been discussed above.

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20. Applicant argues that Morgan does not teach that having a processor, input/output and writing device being associated with a pen-like housing. Association with a housing and inside a housing are different, Morgan clearly discloses that all these things are associated with one another in Figure 3. These things are all shown to be connected which clearly falls within the broadest reasonable interpretation of association.

Conclusion

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. Weber whose telephone number is 571-272-3064. The examiner can normally be reached on Monday - Friday 7am - 4:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CSW

Ronald Agnew
Primary Examiner
4/25/07